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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,738	03/26/2004	Louis C. Haddad	59343US003	9703
32692 7590 01/19/2007 3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			EXAMINER VENC, DAVID J	
			ART UNIT	PAPER NUMBER
			1641	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
31 DAYS		01/19/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/810,738

Applicant(s)

HADDAD ET AL.

Examiner

David J. Venci

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on September 23, 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-31 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-13, 15 drawn to a method comprising, *inter alia*, providing a material comprising sites, classified anywhere in class 216, for example.
- II. Claim 14, drawn to a method comprising, *inter alia*, providing a material comprising particles, classified in class, 264/127 for example.
- III. Claim 16, drawn to a method comprising, *inter alia*, providing a material comprising proteins, classified in class 427/323, for example.
- IV. Claim 17, drawn to a method comprising, *inter alia*, providing a protein, classified in class 435/183, for example.
- V. Claims 18-21, drawn to a product subcombination comprising, *inter alia*, material, classified in class 106/637, for example.
- VI. Claims 22-25, drawn to a product combination comprising, *inter alia*, material comprising particles, classified in class 427/2.14, for example.
- VII. Claims 26-28, drawn to a product combination comprising, *inter alia*, material comprising a membrane, classified in class 442/289, for example.
- VIII. Claims 29-31, drawn to a product combination comprising, *inter alia*, material comprising emulsion, classified in class 516/31, for example.

The inventions are distinct, each from the other because of the following reasons:

Inventions I to IV are related processes. Related processes are distinct from each other if the inventions, as claimed, are not: (1) capable of use together or have a materially different design, mode of operation, function, or effect; (2) overlapping in scope, i.e., are mutually exclusive; and (3) obvious variants. See MPEP § 806.05(j).

Here, Inventions I to IV have different modes of operation because Invention I requires provision of a material comprising sites, while Invention II requires provision of a material comprising particles, while

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Invention III requires provision of a material comprising proteins, while Invention IV requires provision of protein.

The scopes of Inventions I, II and III do not appear to overlap because Invention I requiring a material comprising sites does not appear to infringe Invention II requiring particles, which in turn, do not appear to infringe Invention III requiring a material comprising proteins, which in turn, do not appear to infringe Invention IV requiring provision of protein. In addition, there is no indication on the record of a specific example of a single process that infringes two or more of Inventions I, II, III and IV.

Inventions I, II and III are not obvious variants because materials comprising sites, particles and proteins appear to have different structures having different activities requiring different optimized experimental conditions. Furthermore, there is no indication on the record that the Inventions would have been obvious variants over each other within the meaning of 35 U.S.C. 103(a).

Inventions (VI, VII or VIII) and V are related as combinations and subcombination, respectively.¹ Inventions in this relationship are distinct if it can be shown that (1) the claimed combinations do not require the particulars of the claimed subcombination for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)).

In the instant case, the combination of Invention VI does not require the particulars of the subcombination as claimed because "particles" have separate patentable utility in pharmaceuticals, for example. The combination of Invention VII does not require the particulars of the subcombination as claimed because

¹ Examiner requires restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a

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"membranes" have separate patentable utility in optics systems, for example. The combination of Invention VIII does not require the particulars of the subcombination as claimed because "emulsions" have separate patentable utility in cleaning agents, for example.

The subcombination of Invention V has separate patentable utility as an image-enhancing contrast agent, for example.

Inventions VI, VII and VIII are unrelated to each other. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the inventions have different designs because Invention VI requires "particles", while Invention VII requires "membranes", while Invention VIII requires "emulsions".

Inventions (V, VI, VII or VIII) and (I, II, III or IV) are related as products and processes of use, respectively.² The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case, the products of Inventions V, VI, VII or VIII can be used in cleaning agents, for example.

claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

² Examiner requires restriction between product and process claims. Where Applicant elects to prosecute claims directed to a product, and the product claims are subsequently found allowable, Examiner will consider withdrawing the instant restriction requirement and rejoining non-elected, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claims (i.e., all the process claims must include all the limitations of the allowable product claims). Examiner will not rejoin non-elected, withdrawn process claims that are not commensurate in scope with the allowable product claims. See MPEP § 821.04(b). Thus, where Applicant elects to prosecute claims directed to a product, Examiner advises Applicant to continually amend the non-elected, withdrawn process claims during prosecution to require all the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Upon rejoinder, Examiner will fully examine the rejoined process claims in accordance with 37 CFR 1.104 for compliance with all criteria for patentability, including the requirements of 35 U.S.C. 101, 102, 103 and 112. Examiner further advises Applicant that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where Examiner withdraws the restriction requirement before the patent issues. See MPEP § 804.01.

Examination burden is established because the scope of prior art search required for each Invention does not appear coextensive. For example, a search for the site provision step of Invention I requires a search of prior art related to etching, while a search for particle or particle provision steps of Inventions II and VI requires a search of prior art related to plastics, while a search for Invention III requires a search of prior art related to coating protein, while a search for protein provision of Invention IV requires a search of prior art related to protein purification.

As indicated, *supra*, restriction for examination purposes is proper because the inventions are distinct and require separate, non-coextensive searches of the prior art.

Applicant is advised that a complete reply to this requirement must include: (i) an election of an invention to be examined even if the requirement is traversed³ (37 CFR 1.143), and (ii) identification of the claims encompassing the elected invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Venci whose telephone number is 571-272-2879. The examiner can normally be reached on 08:00 - 16:30 (EST). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


³ Applicant may elect an invention or species with traverse or without traverse. To reserve a right to petition, Applicant must elect with traverse. Should Applicant traverse on the ground that the inventions or species are not patentably distinct, Applicant should clearly admit on the record, or submit or identify evidence on the record that the inventions or species are obvious variants. If Examiner finds one Inventions unpatentable over the prior art, Examiner may use the evidence or admission of record to reject other inventions under 35 U.S.C.103(a).

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

David J Venci
Examiner
Art Unit 1641

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